

Atty Dkt. No. 99PS017/KE

REMARKS

Applicants respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claim 19 is currently being amended. No new matter is added

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-26 remain pending in this application.

In paragraphs 2-3 of the Office Action, claim 19 is rejected under 35 U.S.C. § 112, second paragraph. Applicants have amended claim 19 in accordance with the Examiner's suggestion. Accordingly, withdrawal of the rejection of claim 19 under 35 U.S.C. § 112 is respectfully requested.

In paragraphs 4 and 5 of the Office Action, claims 1-2, 8-10 and 19 are rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 5,729,373 (Sakuyama). In paragraph 6-7 of the Office Action, claims 3-5, 13-15, 18 and 20-22 are rejected under 35 U.S.C. § 103 as being unpatentable over Sakuyama in view of admitted prior art. In paragraph 8 of the Office Action, claims 6, 16-17, 23, and 25-26 are rejected under 35 U.S.C. § 103 as being unpatentable over admitted prior art in view of Sakuyama. Applicants respectfully traverse the rejection.

Applicants reserve the right to swear behind Sakuyama if necessary. Sakuyama is referred to below as a cited art.

The comments below are directed to the rejected claims only. Claims 1-6, 8-10, 13-23 and 25-26 are patentably distinct from Sakuyama, alone or in combination with admitted prior art for at least three reasons. First, not only does Sakuyama fail to teach each and every element of

Atty Dkt. No. 99PS017/KE

the present invention, Sakuyama teaches a superimposition technique which is directly opposite to that of the present invention and teaches away from the present invention. Second, Sakuyama, alone or in combination with the admitted prior art, fails to provide a suggestion for the monitor signal being a static signal explicitly recited in claims 1-6, 8-10, 13-23, and 25-26. Third, Sakuyama relates to the processing of an optical system signal. Sakuyama, alone or in combination with the admitted prior art, does not disclose or suggest the electronic circuitry explicitly recited in claims 1-6, 8-10, 13-23, and 25-26. As discussed below, withdrawal of the rejection under 35 U.S.C. §§ 102 and 103 of claims 1-6, 8-10, 13-23, and 25-26 is respectfully requested in light of the three areas of patentable distinction.

First, Sakuyama does not disclose the “superimposition of data on a static signal” as recited in independent claims 1, 6, 10, 16, 17, 19, 23, 25 and 26. Rather, Sakuyama clearly discloses the superimposition of a monitor signal onto a dynamic signal. Indeed, the line used in Sakuyama for the provision of the monitor signal is a dynamic communication line, not a line for the provision of a status signal. The optical signal 104 provides varying data which communicates information. Sakuyama refers to this signal as the “main signal.” Therefore, Sakuyama cannot possibly disclose or suggest the provision of modulated information on the static signal because it teaches a precisely opposite technique – the provision of a monitor signal on a dynamically changing signal. Indeed, one of ordinary skill in the art following Sakuyama would instead choose to provide a static status signal on a line for communicating varying information in direct opposition to the principles of the present invention.

Second, although Sakuyama discloses a signal which is referred to as a monitor optical signal, the monitor optical signal of Sakuyama is clearly not a static signal as that term is utilized in the present application. As discussed in the previous response, a static signal is a fixed, non-dynamically changing signal indicating status at a voltage level. The monitor signal of Sakuyama relies on its amplitude to convey information. Sakuyama states the monitor optical signal 105 is input to a photo-diode 106 for converting the monitor optical signal into an electric signal in accordance with the intensity of the monitor optical signal. Further, the monitor optical

Atty Dkt. No. 99PS017/KE

signal appears to have a frequency component which is referred to as the monitor signal component. Therefore, the monitor signal is not a static signal as that term is used in the present application.

Third, the present invention utilizes an electronic circuit for modulating and demodulating a signal onto a status signal. In contrast, modulation and demodulation and separation of the monitor and main signal of Sakuyama signals appears to occur at an optical level. Accordingly, one of ordinary skill in the art would utilize an optical scheme rather than the electronic scheme as recited in claims 1-6, 8-10, 13-23 and 25-26.

Further, various dependent claims recite features which are not shown, described or suggested in Sakuyama. Even if Sakuyama is combined with the admitted prior art, there is no indication as to which signals of the specific signals recited in claims 3-6, 13, 14, 16, 17, 18, and 20-26 would utilize the reproducing circuit of Sakuyama. Sakuyama is related to monitoring the status of fiber optic communication lines and does not mention in-flight systems, much less the specific signals of such systems. Indeed, as discussed above, one of ordinary skill in the art following Sakuyama would instead provide a status signal on a communication line, rather than providing varying information on a status signal line because Sakuyama teaches the opposite technique to that of the present invention. Accordingly, it is respectfully submitted that claims 3-6, 13, 14, 16, 17, 18, and 20-26 are additionally patentable over the cited art because Sakuyama does not provide any suggestions for its use with the admitted prior art and even teaches away from its use with a static status signal.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Atty Dkt. No. 99PS017/KE

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 3-3-04By Joseph N. Ziebert

Joseph N. Ziebert  
Attorney for Applicants  
Registration No. 35,421

Foley & Lardner LLP  
777 East Wisconsin Avenue  
Milwaukee, Wisconsin 53202-5306  
Telephone: (414) 297-5768  
Facsimile: (414) 297-4900

-13-

001.1582212.1

Application Serial No. 09/670,971